



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,650	04/19/2000	Paul Bucknell	PHB 34,339	2839

7590

03/06/2003

Corporate Patent Counsel
U S Philips Corporation
580 White Plains Road
Tarrytown, NY 10591

EXAMINER

YUN, EUGENE

ART UNIT

PAPER NUMBER

2683

DATE MAILED: 03/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

92

Office Action Summary

Application No.

09/552,650

Applicant(s)

BUCKNELL ET AL.

Examiner

Eugene Yun

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4 and 6-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-4 and 6-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The corrected or substitute drawings were received on 12/20/2002. These drawings are approved.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 2-4 and 6-16 are rejected under 35 U.S.C. 102(b) as being anticipated by British Telecommunications (BT) (EP 0825791).

Referring to Claim 2, BT teaches a method of operating a radio system comprising first 1 (fig. 1) and second terminals 10 (fig. 1), the method comprising one of said first and second terminals transmitting message giving parameters relating to its capabilities (see col. 5, lines 18-20), and the other of the first and second terminals receiving the message and configuring/reconfiguring itself in accordance with the received parameters (see col. 5, lines 25-33 and 49-53).

Referring to Claim 3, BT also teaches one of the first and second terminals initiating the configuring/reconfiguring operation transmits the required function plus

software required in building a new function into an actual implementation on the other of said first and second terminals (see col. 6, lines 1-4).

Referring to Claim 4, BT also teaches testing the air interface to ensure that configuration/reconfiguration has taken place without error (see col. 6, lines 49-53).

Referring to Claim 6, BT teaches a communications system comprising first 1 (fig. 1) and second terminals 10 (fig. 1) which are able to communicate with each other, wherein at least one of the first and second terminals has means for configuring/reconfiguring itself (see col. 5, lines 25-33 and 49-53) in response to the receipt of a message transmitted by said other of the first and second terminals giving parameters relating to its capabilities (see col. 5, lines 18-20).

Referring to Claim 7, BT also teaches said first and second terminals as radio terminals (see col. 4, lines 27-30).

Referring to Claim 8, BT also teaches said first and second terminals each having a software interface (see col. 2, lines 7-21) including a memory and means for altering the memory (see col. 2, lines 27-29), in that at least a portion of the area of the memory has a part allocated to respective software functions and in that the memory altering means replaces the area of a respective part in response to a new function being downloaded (see col. 5, lines 53-58).

Referring to Claim 9, BT teaches a terminal for use in a communication system in which another terminal 10 (fig. 1) can configure/reconfigure said terminal 1 (fig. 1) by service negotiation, the terminal comprising a transceiver 3 (fig. 1), a memory for storing software functions 7 (fig. 1), and a processor for controlling operation of the terminal in

accordance with stored software functions (see col. 3, line 8), at least one of the software functions being alterable in response to the receipt of a message from said another terminal containing new software function plus interface software required by the processor in building the new function into an actual implementation on the terminal (see col. 5, lines 53-58); said message being selected based on capabilities of said terminal which are transmitted by said terminal to said another terminal (see col. 5, lines 18-20).

Referring to Claim 10, BT teaches a method of configuring a profile of a first terminal comprising:

transmitting capabilities of said first terminal to a second terminal (see col. 5, lines 18-20);

selecting by said second terminal parameters that match said capabilities and transmitting said parameters to said first terminal (see col. 5, lines 35-45);

selecting by said first terminal a portion of said parameters to form selected parameters and informing said second terminal of said selected parameters (see col. 5, lines 49-58); and

transmitting by said second terminal to said first terminal required information to form said profile based on said selected parameters (see col. 6, lines 1-4).

Referring to Claim 11, BT also teaches requesting said capabilities of said first terminal by said second terminal (see col. 5, lines 6-8).

Referring to Claim 12, BT also teaches testing delivery integrity of said required information (see col. 6, lines 49-53).

Referring to Claim 13, BT also teaches testing delivery integrity of said required information (see col. 6, lines 49-53); and

requesting retransmission of said required information if said testing indicates an error in said delivery integrity (see col. 5, lines 53-58 and col. 7, lines 12-19).

Referring to Claim 14, BT also teaches acknowledging proper reception of said required information (see col. 6, lines 4-7).

Referring to Claim 15, BT teaches a communication terminal comprising:
means for transmitting capabilities of said communication terminal to another terminal (see col. 5, lines 18-20);

means for receiving parameters from said another terminal, said parameters matching said capabilities (see col. 5, lines 35-45);

means for selecting a portion of said parameters to form selected parameters and informing said another terminal of said selected parameters (see col. 5, lines 49-58);

means for receiving from said another terminal required information to form a profile of said communication terminal based on said selected parameters (see col. 6, lines 1-4); and

means for configuring said profile in response to said required information from said another terminal (see col. 6, lines 4-7).

Referring to Claim 16, BT teaches a communication terminal comprising:
a memory which stores data indicative of capabilities of said communication terminal (see col. 2, lines 27-29);

a transmitter which transmits said capabilities to another terminal (see col. 5, lines 18-20);

a receiver which transmits said capabilities to another terminal (see col. 5, lines 35-45);

a controller which selects a portion of said parameters to form selected parameters and informs said another terminal of said selected parameters (see col. 5, lines 49-58);

said receiver receiving from said another terminal required information to form a profile of said communication terminal based on said selected parameters (see col. 6, lines 1-4); and

said controller configuring said profile in response to said required information from said another terminal (see col. 6, lines 4-7).

Response to Arguments

4. Applicant's arguments filed 11/5/2002 have been fully considered but they are not persuasive.

The applicant argues that BT does not teach a terminal that transmits a message giving parameters relating to its capabilities. The passage in col. 5, lines 18-20 reads on that characteristic of the applicant's claims almost verbatim, clearly describing that the base station "transmits a signal indicating its **capabilities** to the mobile telephone".

The applicant also argues that BT does not teach a configurable terminal. The passage in col. 5, lines 25-33 states that the mobile terminal arranges itself to acquire a

Art Unit: 2683

certain capability if it already doesn't have it. That can be considered configuring a terminal even though the process as a whole may take longer in BT than in the applicant's claimed invention.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Yun whose telephone number is (703) 305-2689. The examiner can normally be reached on 8:30am-5:30pm Alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William G Trost can be reached on (703) 308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

Art Unit: 2683

872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Eugene Yun
Examiner
Art Unit 2683

EY
February 26, 2003



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600